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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,421	11/21/2003	John Eric Peckham	03-0388 (US01)	3394
41696 7590 02/15/2011 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070			EXAMINER CHENG, JACQUELINE	
			ART UNIT 3777	PAPER NUMBER
			MAIL DATE 02/15/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,421

Applicant(s)

PECKHAM, JOHN ERIC

Examiner

JACQUELINE CHENG

Art Unit

3777

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-15,17-19,21-27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-15,17-19,21-27 and 37 is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's amendments and arguments filed November 18, 2010, with respect to the 35 U.S.C. 103(a) claim rejections of claims 1, 4-15, 17-19, 21-27, and 37 and the 35 U.S.C. 112, first paragraph rejection of claim 36 have been fully considered and are persuasive. These rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made for claim 36 over Lee (US 5,203,777) in view of Makower'875 (US 6,302,875 B1).

Claim Objections

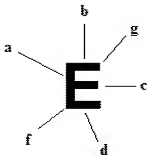
2. **Claim 36** is objected to because there is insufficient antecedent basis for the recited limitation "a second portion". It is unclear if the "a second portion" is the same or different from the previously mentioned "a second portion". Suggested language is either --of the medical device ~~and a second portion~~ and a second portion contiguous to said first portion-- or --of the medical device and a second portion ~~and a, the~~ second portion contiguous to said first portion--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US 5,203,777) in view of Makower'875 (US 6,302,875 B1). Lee discloses a medical device 110 (fig. 6a) and a marker 130 (fig. 7a, 7b) having a first portion (element a in fig. below) linearly

extending parallel to the longitudinal axis of the medical device and a second portion (element b in fig. below) contiguous to said first portion and extending circumferentially about the longitudinal axis of the medical device, having a first end (element f in fig. below) and a second end (element g in fig. below) being offset from one another along the length and a circumferential direction of the device, having a first directional indicator (element c in fig. below) and a second directional indicator (element d in fig. below) each intersecting said marker and comprising a portion of a symbol. When images of the marker is taken the first and second directional indicators connect to form the symbol "E" when viewed from a proper rotational orientation about the longitudinal axis when viewed orthogonally to the longitudinal axis. When not properly rotationally aligned the directional indicators connect to form a different symbol of a backwards E.

4. Lee discloses all of what is claimed except for the marker being a marker wire. In the same field of endeavor Makower'875 discloses markers being made from radiopaque materials and such a radiopaque material being metal wire (col. 16 line 23-24). It would have be obvious to one skilled in the art at the time the invention was made to use metal wire as disclosed by Makower'875 as the marker material of Lee as Lee discloses that the radiopaque markers can be made from a suitable conventional metal.



Allowable Subject Matter

5. Claims 1, 4-15, 17-19, 21-27, and 37 are allowed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACQUELINE CHENG whose telephone number is (571)272-5596. The examiner can normally be reached on M-F 10:00-6:30.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Chen can be reached on 571-272-3672. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jacqueline Cheng/
Examiner, Art Unit 3777

/Tse Chen/
Supervisory Patent Examiner, Art Unit 3777